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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,294

Applicant(s)

JOHNSON, RONALD FREDRIK
MICHAEL

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on July 6, 2005. This application was under a final rejection (the First Final Office Action, mailed January 6, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the First Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant's response filed July 6, 2005 is acknowledged. Accordingly, claims 1-3 and 5-19 remain pending.

3. This Office Action, the "Third Non Final Office Action" is given Paper No. 20050915. A "Second Non Final Office Action" was mailed April 7, 2004 while the "First Non Final Office Action" was mailed July 29, 2003.

4. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

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5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Written Description

7. Claims 1-3 and 5-19 are rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. Claims 1 and 12 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, Applicant has not disclosed how the server “provides real time access to inventory information stored in the database by pushing inventory information to at least one client” Applicant’s specification describes that that Browser 200 first initiates the requests and only then does web server respond. As an alternative, Applicant adds in his specification “or ‘push’ said changes to a client.” This is not necessarily disclosing “pushing” the real time inventory information to at least one client.

8. It is the Examiner’s factual determination that Applicant’s original specification does not *necessarily disclose* a server which provides *real time* access to inventory information stored in

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the database by pushing the inventory information to a client. While the Examiner admits that this may be 'obvious' in view of Applicant's disclosure, it is nevertheless not *necessarily* present.

9. Finally, the Examiner adds that Applicant's own "Remarks/Arguments" challenge the Examiner's factual determination that "'push/pull' technology was well known in the relevant arts at the time the invention was made."¹

Enablement

10. Claims 1 and 12 are rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, Applicant has not disclosed how, to one of ordinary skill in the art, the claimed server provides *real-time* information by "pushing" inventory information to at least one client. If Applicant admits on the record that it is old and well known in the art for 'servers to provide real time access to inventory information stored in databases by pushing the inventory information to at least one client,' this particular 35 U.S.C. §112, 1st paragraph will be withdrawn.

Claim Rejections - 35 USC §112 2nd Paragraph

11. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

¹ Applicant's "Remarks/Arguments" filed July 6, 2005, Page 14, ~ lines 24-26.

12. Claims 1-3, 5-19 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. In claim 1, it is unclear if “a client” as recited in line 8 is included in the set of “at least one client” recited in line 7. For prior art purposes only and based upon the claim language, the Examiner interprets “a client” as not necessarily being inclusive or within “at least one client.”
- b. In claim 12, the phrase “corresponding on-hand inventory item quantities” is indefinite because it not known in reference to what the “corresponding” is referring to.
- c. Also in claim 12, it is unclear if the “inventory item quantities” in line 10 is the same or different from the inventory item quantities as recited in line 3.
- d. Also in claim 12, it is unclear if the “at least one inventory item quantity” as recited in line 15 is the same or different from the quantities in line 3.
- e. Also in claim 12, it is unclear if the “at least one inventory item quantity” as recited in line 15 is the same or different from the “inventory item quantities” in line 10.
- f. In claim 12, it is not known which inventory items are within the “corresponding quantity of inventory items”
- g. Also in claim 12, it is unclear if “shipment” in reference to a 3rd party shipping inventory ‘to’ operator of the database or, alternatively, shipping inventory ‘out from’ or ‘away from’ the operator of the database.

Claim Rejections - 35 USC §102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. The Examiner acknowledges that anticipation requires the Examiner to meet the ‘All Elements Test.’ “To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In other words, all elements of the claimed invention must be disclosed in some fashion for the claim to be anticipated. Logically, the lack of a single element would negate anticipation. “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

15. Yet it is important to keep in mind that “[a]n anticipatory reference, however, need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). “While a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests” *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) (citations and quotations

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omitted).² In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).³

16. Additionally, it is the Examiner’s position that for anticipation, the Examiner can combine that what is old and well known in the art in combination with a reference. “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701. See also *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000) (noting that “The brochure might nevertheless be anticipating if a person of ordinary skill in the art would understand the brochure as disclosing elements (8)-(10) and if such a person could have combined the brochure’s description of the invention with his

² See also *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965)(noting that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests).

³ See MPEP §2123, Subsection titled “Patents Are Relevant as Prior Art for All They Contain.”

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own knowledge to make the claimed invention.”); and *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) “Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention” citing *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74.

17. With the above in mind, claims 1-3 and 5-19, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Peterson et. al. (U.S. 6,324,522) (“Peterson ‘522”), Greene’s Production and Inventory Control Handbook, and Gralla’s How the Internet Works. This is a multiple reference anticipation rejection.⁴

18. Peterson ‘522 discloses a web based, real time inventory system. As noted in the First Final Office Action, Peterson ‘522 directly discloses the following:

It should also be noted that much of the Inventory Network function discussed herein, like other functions of the information network process 100, are described as batch functions, rather than real time transactions. That is, as will be discussed below, a vendor will periodically generate a computer file containing a listing of the vendor's inventory, and upload that file to the information network, where it is merged with other vendors' files to generate a picture of the inventory available in the entire distributor network which participates in the inventory network. However, it is specifically contemplated, and within the scope of the invention, that such functions could be done in a real time fashion. Peterson ‘522, C14, ~L23-36.

19. Additionally, Peterson ‘522 discloses a real-time, web server which provides access to an inventory database which receives and displays to the user via the browser interface inventory information:

However, it is specifically contemplated, and within the scope of the invention, that such functions be replaced with *a real time connection to the*

⁴ See MPEP §2131.01 III expressly authorizing multiple reference anticipation rejections.

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inventory control system that resides at the vendor's locality. For example, any queries generated by an end user would be relayed over a direct connection from the web server to the inventory control database residing at the vendor's locality. *That database would then generate responses to the queries, which the web server would receive and display to the user via the browser interface.* Any purchase orders submitted by the end user would then be relayed directly to the vendor's on-site inventory control database, making the necessary changes to order status and on hand inventory in real time. This real time functionality would then replace any batch activities, such as uploading files to and downloading orders from the information network. [Emphasis added.] Peterson '522, C43, L15-30

20. Peterson '522 also discloses an Inventory Network [C13, L40 to C20, L65] and a client (the web interface using NETSCAPE [C6, L42-66]) which accesses a sever (a web based application must access a web server).

21. While Peterson '522 directly discloses the client as Netscape, Peterson '522 does not show all the elements of Netscape or all of the functionality of Netscape. Gralla however teaches using Netscape to push web based content from web servers to clients (Chapter 33, pp 190-197). In particular, Gralla teaches how Netscape is used to push content from a web server to a client (pg 194-195). It is the Examiner's factual determination that these features in Netscape as shown in Gralla are inherent in Peterson '522 because Peterson '522 directly discloses the use of the Netscape browser and Gralla teaches various features of the Netscape browser. Additionally, Gralla also discloses in Chapter 28 how web host servers work. In particular, Gralla discloses on pages 168-169 shows how a web client accesses a database.

22. Additionally Peterson '522 does not directly disclose fields in an inventory record. Such fields contain information which is considered basic information for managing the inventory. Green (pp 18.15 to 18.16) directly teaches storing the inventory information stored in the database. See Table 18.5 on page 18.16. While keeping track of the inventory in Peterson '522, Peterson '522 does not disclose how it tracks the inventory transactions. However Green in

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Table 18.7 on page 18.17 teaches an inventory transaction table that is inherent in Peterson '522.

In particular, Table 18.7 in Green teaches tracking ordered, on-hand, and recovered (*i.e.*

allocated) inventory. Again it is the Examiner position that these features of Green are inherent

in Peterson '522 because Peterson'522 does not disclose the file structure of the inventory data

stored. In addition to the above, Green also directly discloses types of inventory attributes that

are stored in a typical inventory system. See Green, p 30.23, Table 30.4; and p 30.24, Table 30.5.

Claim Rejections - 35 USC §103

23. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1-3 and 5-19, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '522, Green, and Gralla.⁵ It is the Examiner's principle position that the claims are anticipated because of the inerencies noted above in Peterson '522.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson '522 as taught by Green to include the data structure as described in Green. Such a modification would have simply disclosed that which is inherent. Moreover, such a modification would have increased inventory accuracy.

⁵ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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And it is the Examiner factual determination⁶ that increasing accuracy of inventory helps prevent large alterations of profits and allows the purchasing staff to properly order replacement parts.

See e.g. Bragg's Accounting Best Practices, page 240.⁷

Additionally, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson '522 /Green combination as taught by Gralla to expressly recite the features of Netscape. Such a modification would have simply disclosed that which is inherent. Furthermore, it is the Examiner's factual determination that accessing the inventory data quickly is a desired feature. And by using the Netscape's push technology, the user would be able to view the inventory data offline just in case there was an interruption in either the satellite or ground based Internet connection. As noted in Gralla on page 195 #7:

Because the information and pages are local instead of on the Internet they can be accessed when the user is not connected. They can also be accessed quickly because they're being read from a hard disk instead of across the Internet.

25. Claims 1-3 and 5-19, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable Claims 1-3 and 5-19, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Cornett et. al. (U.S. 5,216,612) ("Cornett") in view of Gralla. Cornett directly discloses a database (Figure 1) storing on hand inventory [C15, L50-61] and/or [C32, L65-L69]; storing reserved stock inventory [C27, L65 to C28, L3]; ordered

⁶ Whether motivation to combine the references was shown is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000) (citations omitted).

⁷ In obviousness rejections, other reference(s) (which are not expressly stated in the statement of rejection) may be used to provide the motivation to combine. *In re Huston*, 308 F.3d 1267, 1278-79, 64 USPQ2d 1801, 1808-09 (Fed. Cir. 2002). See also *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (rejecting applicant's argument that the prior art must contain an express suggestion to combine).

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inventory [C15, L50-L61]; a communication interface (“engineering change control management subsystem”) which provides access to the database file system [C5, L63-66]; a server which provides real-time access to inventory information (“The parts manual file 7 is maintained in a central location”) [C14, L5-L14]; and a client can communicate with the server. Cornett does not directly disclose a wireless connection. Gralla teaches a wireless connection (e.g. satellite connection on pg 75-77) to as way to receive high speed Internet content; pushing web based content to user (Chapter 33, pp 190-197, with #2 on pg 192 an exemplary embodiment).

26. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Cornett as taught by Gralla to include a wireless web connection utilizing push technology. Such a modification would have allowed the users to view the information offline in case the satellite reception became poor.

27. For due process purposes and because Applicant has not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicant has decided not to be his own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.⁸ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim

⁸ See the Second Non Final Office Action mailed April 7, 2004, Paragraph No. 16; the First Final Office Action mailed January 6, 2005, Paragraph No. 28.

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with which to draw in those statements⁹ with the required clarity, deliberateness, and precision.¹⁰

Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,¹¹ Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography *was* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation¹² to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—has not changed the Examiner's reasonable conclusion that Applicant has decided not to be his own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the

⁹ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

¹⁰ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

¹¹ See Note 7.

¹² See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was

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heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.¹³

28. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and are provided in accordance with *In re Morris* as a factual source to support the Examiner’s claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹⁴) during ex parte examination.

Response to Arguments

29. Applicant’s arguments filed with the RCE have been fully considered but they are not persuasive.

interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.”

¹³ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

¹⁴ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

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30. Applicant's arguments with respect to 35 U.S.C. §101 are persuasive. The 35 U.S.C. §101 rejections have been withdrawn since the claimed method steps must include at least one computer.

Anticipation Rejections

31. Applicant argues that all elements are not shown. While this is not determinative of anticipation or obviousness, the Examiner has attempted to show where each and every element is shown in the claims.

32. Next "Applicant also asserts that the discloses in Johnson and/or Peterson would not enable one of ordinary skill in the art to make or practice Applicant's claimed invention."¹⁵ As noted by the Examiner in the previous office action,¹⁶ it is unclear if Applicant is arguing the references themselves lack enablement or some other concept. Applicant is respectfully requested to clarify what he states is not enabling. The Examiner maintains his position on enablement as noted in the First Final Office Action.

33. It is the Examiner's position that an argument of a lack of an enabling disclosure of a reference must assume that the 'All Elements Test' has been met. It is therefore unclear if Applicant is asserting that the All Elements Test has not been met or some other issue. Applicant's arguments have been considered but are not persuasive.

34. In any event, the Examiner cites White's How Computers Work; Gralla's How the Internet Works; Greene's Production and Inventory Control Handbook, Dobler's Purchasing and

¹⁵ Applicant's "Remarks/Arguments filed July 6, 2005, Page 7, ~ lines 5-6.

¹⁶ See the First Final Office Action mailed January 6, 2005, Pg 14, Paragraph No. 35.

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Supply Management, Text & Cases; Borland's Paradox for Windows User's Guide, Muller's Desktop Encyclopedia of the Internet; and Gavron's How to Use Micosoft Windows NT 4 Workstation as additional evidence to show that the prior art document(s) relied upon to reject the claims under either 35 U.S.C. §§102 or 103 are enabling. See e.g. MPEP §2131.01 I.; and *In re Samour*, 571 F.2d 559, 197 USPQ 1, 4-5 (CCPA 1978).

Inherency

35. Applicant argues that "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill."¹⁷

36. First, this statement of law is simply not true since one of ordinary skill need not recognize the inherent disclosure. The Federal Circuit has continually held that "inherent anticipation does not require that a person of ordinary skill in the art at the time would have recognized the inherent disclosure." *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1667 (Fed. Cir. 2003) (citations omitted). See also *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999 and *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999) ("Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art."). "In sum, [the Federal Circuit's] precedent does not require a skilled artisan to recognize the inherent characteristic in the prior art that anticipates the claimed invention."

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Schering Corp. v. Geneva Pharmaceuticals, Inc., 339 F.3d at 1378, 67 USPQ2d at 1668. For this reason alone, Applicant's statement of law is simply incorrect.

37. Second, Applicant argues that "the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference" However the Examiner is not relying on *any* extrinsic evidence. To be especially clear, *all evidence relied upon by the Examiner is intrinsic evidence*. For this reason alone, Applicant's statement of law is moot since it is not on point.

38. It is the Examiner's position that showing an element is inherent based upon a "preponderance of the evidence" is synonymous with showing that "the disclosure of the prior art is sufficient to show that the natural result flowing from the operation as taught in the prior art would result in the claimed product." *SmithKline Beecham Corp. v. Apotex Corp.*, 74 USPQ2d 1398, 1406, (Fed Cir. 2005)(citations and quotations omitted). In other words, the 'natural flowing result' is what is most likely to happen. It is axiomatic that the natural flowing result is the result that is shown by a preponderance of the evidence. Conversely, if a given event is *not* the natural flowing result, it can not be supported by a preponderance of the evidence.

¹⁷ Applicant's "Remarks/Arguments", Page 10 , 2nd ¶.

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Other Matters

39. Applicant traverses the Examiner's factual determinations. While the Examiner disagrees with Applicant's conclusion on this matter, Applicant's response is noted for the record.

40. In particular, Applicant asserts that the Examiner has not shown that that "push/pull" technology was well known in the relevant arts at the time the invention was made."

41. To be clear, Applicant is respectfully requested to pick one side or the other: is push technology old and well known or not? It's a simply question. This determination is now key in this application.

Official Notice

42. As noted in the First Final Office Action, Page 6, Paragraph No. 20, Official Notice statements made in the First Non Final Office Action are considered admitted prior art.

43. Applicant's attempt at traversing the Examiner's finding that custom software is used in inventory systems such as browsers is inadequate. See for e.g. the Java programming in Gralla. It is the Examiner's factual determination that HTML and JavaScript programming used to implement the push technology in Netscape is customer programming.

44. Additionally, adequate traversal is a two step process. First, Applicant must state his traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires Applicant to specifically point out the supposed errors in the Office Action, Applicant must state why the statement(s) are not to be considered common knowledge or well known in the art.

In this application, while Applicant has clearly met step (1), Applicant has however failed

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step (2) since he has failed to argue *why* the statement(s) are not to be considered common knowledge or well known in the art. Because Applicant's traversal is inadequate, the statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

Declarations

45. The declaration of Roy Rubin under 37 C.F.R. §1.132 filed July 6, 2005 ("First Ruben Declaration") is insufficient to overcome the rejection of claims 1-3 and 5-19 based upon the rejections as set forth in the last First Final Office Action and the rejections as set forth in this Third Non Final Office Action.

46. The declaration of Wallace E. Reeves under 37 C.F.R. §1.132 filed July 6, 2005 ("First Reeves Declaration") is insufficient to overcome the rejection of claims 1-3 and 5-19 based upon the rejections as set forth in the last First Final Office Action and the rejections as set forth in this Third Non Final Office Action.

47. The declaration of Jas Kalsi under 37 C.F.R. §1.132 filed July 6, 2005 ("First Kalsi Declaration") is insufficient to overcome the rejection of claims 1-3 and 5-19 based upon the rejections as set forth in the last First Final Office Action and the rejections as set forth in this Third Non Final Office Action.

48. The First Ruben Declaration, the First Reeves Declaration, and the First Kalsi Declaration taken together or collectively are called the "July 6 Declarations."

49. After consideration of all the evidence of record, the Examiner finds that the July 6 Declarations are not persuasive to overcome the rejections based on Peterson '522 because the statements made therein are contradicted by the evidence of record.

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50. For example, the First Ruben Declaration expressly states on page 4 that “Peterson cannot be seen as either explicitly or inherently teaching discloses the store of on-hand . . . inventory”¹⁸ If Peterson ‘522 is not disclosing “on hand” inventory, what inventory is it disclosing in the “INVENTORY NETWORKS” in column 13? In other words, the First Ruben Declaration is in direct conflict with Taylor’s Management Science, p 662, which expressly states “Inventory is defined as a stock of items kept on hand by an organization to meet customer demand.” Clearly Peterson ‘522 discloses on hand inventory. The First Ruben Declaration adds that “Most inventory databases in use at the time, and in fact most inventory databases in use today, simply track the number of items presently in stock.” Again, isn’t this “on hand” inventory?

51. Additionally, the Examiner notes that the First Ruben Declaration does not provide any objective evidence of record to support its position. In conclusion, the Examiner finds that the First Rubin Declaration is not persuasive because the statements made are contradicted by the evidence of record.

52. The First Reeves Declaration is also not persuasive because the statements made are therein contradicted by the evidence of record. Like the First Ruben Declaration, the First Reeves Declaration expressly states on page 4 that “Peterson cannot be seen as either explicitly or inherently teaching discloses the store of on-hand . . . inventory”¹⁹ Again, if Peterson ‘522 is not disclosing “on hand” inventory, what inventory is it disclosing in the “INVENTORY

¹⁸ First Ruben Declaration, Pg 4, ~ L4-L5.

¹⁹ First Reeves Declaration, Pg 3, last ¶.

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NETWORKS” in column 13? The deficiencies in the First Rubin Declaration are also present in the First Reeves Declaration.

53. Finally, the First Kalsi Declaration is also not persuasive because the statements made therein are contradicted by the evidence of record. Again, the First Kalsi Declaration expressly states on page 4 that “Peterson cannot be seen as either explicitly or inherently teaching discloses the store of on-hand . . . inventory”²⁰ Again, if Peterson ‘522 is not disclosing “on hand” inventory, what inventory is it disclosing in the “INVENTORY NETWORKS” in column 13?

54. Additionally, the Examiner finds that Greene contradicts the factual statements made in the July 6 Declarations. In particular, Table 18.7 directly discloses tracking ordered, received, issued, on-hand, and reserved (or allocated) inventory and therefore contradicts the factual statements made in the July 6 Declarations.

55. The Examiner as factfinder has broad discretion as to the weight to give to declarations offered in the course of prosecution. The Examiner has carefully considered the July 6 Declarations. However, because the July 6 Declarations are contradicted by the evidence of record including but not limited to Peterson ‘522, Taylor, and Greene; because of the other deficiencies noted above; and because July 6 Declarations have not offered any other evidence to support the factual statements therein, the Examiner finds that this lack of factual corroboration in combination with the other deficiencies warrants discounting the opinions expressed in the July 6 Declarations. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1368, 70 USPQ2d 1827, 1833 (Fed. Cir. 2004) (citations and quotation omitted).

²⁰ First Kalsi Declaration, Pg 4, ~ 3rd ¶.

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56. While the Examiner respectfully disagrees, Applicant's traversal of the Examiner's assertion that Paradox for Windows is evidence of what is considered basic knowledge or common sense is noted for the record. A review of the reference will show that the concepts, constructs, and disclosures of a relational database system are old and well known in the art.

57. While Applicant's remaining arguments are considered not persuasive, Applicant's arguments are noted for the record.

Conclusion

58. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

59. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

60. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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61. Applicant is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant’s response is made of record) both Applicant’s request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

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62. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference, Production and Inventory Control Handbook, 3rd Ed. with James H. Greene as Editor-in-Chief ("Greene") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. First, the Examiner finds that Greene provides an introduction to the basics of production and inventory control. In other words, Greene covers production and inventory control in its broadest sense. The Examiner also finds that the reference is a introductory handbook which serves at least professionals, students, and persons designing control systems. The reference is cited in its entirety. In particular, Greene is about planning, controlling, and managing production and inventories through systems and an organization; and applying principles, methods, and models, based on facts, knowledge, forecasts, and predictions to accomplish goals and objectives. Finally, the Examiner finds that Greene includes discussions which are broad enough to include both large and small businesses; covers the process industries as well as the assembly and fabrication industries; covers businesses that produce to order as well as those that ship 'off the shelf;' and concerns itself with distribution inventories as well as manufactured inventory, from the simple manufacturing processes to the very complex. Because "[w]ell known text books in English are obvious research materials." *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), because of the factual findings noted in this paragraph, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Greene is primarily directed towards those of low skill in this art. Because Greene is directed towards those of low

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skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Greene.

63. Also in accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

64. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks/Arguments" (beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or

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legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,²¹ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
September 16, 2005

²¹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.